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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,328	08/10/2005	Stefan Rott	1093-126 PCT/US	6933

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EXAMINER

OLSZEWSKI, JOHN

ART UNIT	PAPER NUMBER
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3618

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,328

Applicant(s)

ROTT ET AL.

Examiner

John R. Olszewski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8,21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11 February 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.** See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, **claim 15** recites the broad recitation "the cover layer comprises a printing ink or a lacquer", and the claim also recites "in particular a casting lacquer, a dip lacquer or a spray lacquer" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

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2. Claims 1-4, 10-11, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248).

With regards to claim 1, Rohrmoser discloses:

- A mechanically load-bearing layer with preferably a high modulus of elasticity is arranged on a surface of the multilayer transfer or laminating film (Figure 2, Item 6)
- A cover layer is arranged on another surface of the multilayer transfer or laminating film (Figure 2, Item 12)

With regards to claim 1, Rohrmoser lacks, but Hastings III et al. teaches:

- A multilayer transfer or laminating film of a thickness of less than 125 μm and comprising two or more thin layers (Figure 1, Items 10, 11, 12, and 13)

It would have been obvious to one of ordinary skill in the art to take the teachings of Hastings III et al. and incorporate them into the invention of Rohrmoser in order to provide a multilayer laminating film to provide a durable assembly resistant to wear. With regards to the thickness of the film it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the thickness of the laminating film less than 125 μm , since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With regards to claim 2, Rohrmoser lacks, but Hastings III et al. teaches:

- The transfer or laminating film has:
 - An adhesive layer (Figure 1, Item 11)
 - A functional layer (Figure 1, Item 12)
 - A release layer (Figure 1, Item 13)

Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hastings III et al. into the invention of Rohrmoser in order to provide a stronger more durable laminate.

With regards to claim 3, Rohrmoser lacks, but Hastings III et al. teaches:

- The release layer is a clear lacquer layer, which acts as a bonding layer in relation to the cover layer (Figure 3, Item 23; discloses the use of a clear lacquer layer)

Therefore it would have been obvious to one of ordinary skill in the art to take the teachings of Hastings III et al. and incorporate them into the invention of Rohrmoser in order to provide an alternate means for bonding one item to another and to allow for items to be viewed through said release layer.

With regards to claim 4, Rohrmoser lacks, but Hastings III et al. teaches:

- The functional layer has a metal layer (Figure 1, Item 12)

Therefore it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hastings III et al. into the invention of Rohrmoser in order to provide a stronger more durable laminate.

With regards to claim 10, Rohrmoser lacks, but Hastings III et al. teaches:

- The cover layer and the mechanically load-bearing layer are each respectively thicker than the transfer or laminating film, wherein the cover layer is in particular of a thickness of between 50 and 125 μm and the mechanically load-bearing layer is in particular of a thickness of between 100 μm and 2 mm

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover layer and the mechanically load-bearing layer are each respectively thicker than the transfer or laminating film, wherein the cover layer is in particular of a thickness of between 50 and 125 μm and the mechanically load-bearing layer is in particular of a thickness of between 100 μm and 2 mm, since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With regards to claim 11, Rohrmoser discloses:

- The mechanically load-bearing structure is embossed or structured (Figure 2, Item 6; clearly structured in that channels [30] are run down longitudinally on the core [6], i.e. the mechanically load-bearing structure)

With regards to claim 16, Rohrmoser discloses:

- The cover layer is structured (Figure 2, Item 12)

With regards to claim 18, Rohrmoser discloses:

- A multilayer film as set forth in claim 1 is applied to the ski base body on the side of the ski in opposite relationship to the sole running surface (Figure 2; clearly depicts this orientation; the base body consisting of items 5, 7, 24, and 25)

With regards to claim 19, Rohrmoser discloses:

- The mechanically load-bearing layer is joined to the ski base body (Figure 2, clearly depicts item 6 joined to the base body items 5, 7, 24, and 25)

With regards to claim 20, Rohrmoser discloses:

- The cover layer is joined to the ski base body (Figure 2, Item 12; clearly bonded to the previously indicated base body)

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Vermeulen et al. (US 6,210,777).

With regards to claim 5, Rohrmoser lacks, but Vermeulen et al. teaches:

- The functional layer has a thin film layer succession which produces color shifts by means of interference (Figure 1)

Therefore it would have been obvious to one of ordinary skill in the art to take the teachings of Vermeulen et al. and incorporate them into the invention of Rohrmoser in order to provide a specific type of design on the runner board.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Chatwin et al. (US 5,492,370).

With regards to claim 6, Rohrmoser lacks, but Chatwin et al. teaches:

- The functional layer has a replication layer into which a diffractive structure or a macrostructure is embossed (Column 11, Lines 7-36)

Therefore it would have been obvious to one of ordinary skill in the art to take the teachings of Chatwin et al. and incorporate them into the invention of Rohrmoser in order to provide a specific type of design on the runner board.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Ochiai III et al. (US 6,008,581).

With regards to claim 7, Rohrmoser lacks, but Ochiai III et al. teaches:

- The functional layer has an HRI layer (Column 7, Lines 23-38)

Therefore it would have been obvious to one of ordinary skill in the art to take the teachings of Ochiai et al. and incorporate them into the invention of Rohrmoser in order to provide a specific type of design on the runner board.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Breitler et al. (US 5,589,275).

With regards to claim 9, Rohrmoser lacks, but Breitler et al. teaches:

- The transfer or laminating film is deep-drawable (Column 2, Lines 29-35)

Therefore it would have been obvious to one of ordinary skill in the art to take the teachings of Breitler et al. and incorporate them into the invention of Rohrmoser in order to provide a specific type of design on the runner board.

7. Claims 13-15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Lavorel et al. (US 5,437,755).

With regards to claim 13, Rohrmoser lacks, but Lavorel et al. teaches:

- The cover layer is transparent (Figure 12, Item 1)

Therefore it would have been obvious to one having ordinary skill in the art to take the teachings of Lavorel et al. and incorporate them into the invention of Rohrmoser in order to provide visible images on a runner board of some type, that would not wear away with use.

With regards to claim 14, Rohrmoser lacks, but Hastings III et al. teaches:

- The cover layer comprises a thermoplastic material (Column 5, Lines 3-12)

With regards to claim 15, Rohrmoser lacks, but Lavorel et al. teaches:

- The cover layer comprises a printing ink or a lacquer, in particular a casting lacquer, a dip lacquer or a spray lacquer (Columns 4-5, Lines 51-12, respectively)

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Riepler (US 5,944,335).

With regards to claim 17, Rohrmoser lacks, but Riepler teaches:

- Additional decoration is printed on to the multilayer transfer or laminating film (Column 4, Lines 47-59)

Therefore it would have been obvious to one of ordinary skill in the art to take the teachings of Ochiai et al. and incorporate them into the invention of Rohrmoser in order to provide a specific type of design on the runner board.

9. **Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248).**

With regards to claim 1, Rohrmoser discloses:

- A mechanically load-bearing layer with preferably a high modulus of elasticity is arranged on a surface of the multilayer transfer or laminating film (Figure 2, Item 12)
- A cover layer is arranged on another surface of the multilayer transfer or laminating film (Figure 2, Item 6)

With regards to claim 1, Rohrmoser lacks, but Hastings III et al. teaches:

- A multilayer transfer or laminating film of a thickness of less than 125 μm and comprising two or more thin layers (Figure 1, Items 10, 11, 12, and 13)

It would have been obvious to one of ordinary skill in the art to take the teachings of Hastings III et al. and incorporate them into the invention of Rohrmoser in order to provide a multilayer laminating film to provide a durable assembly resistant to wear. With regards to the thickness of the film it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the thickness of the laminating film less than 125 μm , since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrmoser (US 5,690,349) and in view of Hastings III et al. (US 2,858,248), and further in view of Lavorel et al. (US 5,437,755).

With regards to claim 12, Rohrmoser lacks, but Lavorel et al. teaches:

- The mechanically load-bearing layer is transparent (Figure 12, Item 1)

Therefore it would have been obvious to one having ordinary skill in the art to take the teachings of Lavorel et al. and incorporate them into the invention of Rohrmoser in order to provide visible images on a runner board of some type, that would not wear away with use.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

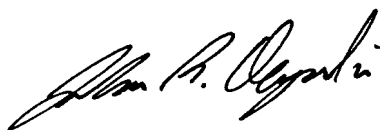
- LeGrabd et al. (US 4,671,529), Pascal et al. (US 5,288,097), Lorenz et al. (US 5,591,509), Meatto et al. (US 4,639,009), Legrand et al. (US 5,057,170), and Menges (US 6,293,567)
 - Disclose structure similar to that claimed and disclosed by applicant

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Olszewski whose telephone number is 571-272-2706. The examiner can normally be reached on M-Th 5:30AM-4PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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9/27/2007



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